

REMARKS

Claims 1, 4, 6-11, 14 and 16-22 are pending in the application.

Claims 1, 4, 6-11, 14 and 16-22 are rejected.

Reconsideration and allowance of claims 1, 4, 6-11, 14 and 16-22 is respectfully requested in view of the following:

Responses to Rejections to Claims – 35 U.S.C. §112

Claims 1, 11 and 21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The Examiner asserts that "[c]laim language requires both power sources from the power adapter and from the computer via the power line of the Newcard device that is not supported by the disclosure." Office action dated 1/29/08, page 2. However, support for the claim language can be clearly found in the specification. Applicant respectfully submits that support for the claimed power schemes may be found at least at paragraph [0034] in the original application. Paragraph [0034] includes, in part, "In one embodiment, an optional power adapter module 290 provides power to the second subsystem 120 including the user console 210...In one embodiment, the second subsystem 120 including the user console 210 derives power from the mail chassis via a power line 293 of the Newcard device 100." Applicant kindly requests withdrawal of the rejection.

Responses to Rejections to Claims – 35 U.S.C. §103

Claims 1, 4, 6-11, 14 and 16-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sleeman (U.S. Publication No. 2004/0260843) (Sleeman) in view of Saunders (Newcard Exposed) (Saunders), and further in view of Odaohhara et al (U.S. Patent No. 7,206,944) (Odaohhara). Claims 9-10 and 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sleeman as applied to Saunders above, and further in view of Cheng et al (U.S. Patent No. 6,935,130) (Cheng). These rejections are not applicable to the claims.

As the PTO recognizes in MPEP §2142:

The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the Examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

The USPTO clearly cannot establish a *prima facie* case of obviousness in connection with the claims for the following reasons:

35 U.S.C. §103(a) provides that:

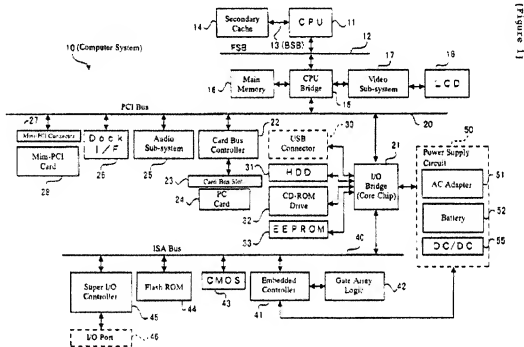
[a] patent may not be obtained...if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.... (emphasis added)

Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. However, the references, alone, or in any combination, do not teach at least the limitation of a "power means including a power adapter connected to provide power to the second subsystem including the user console, whereby the power adapter is operable to receive an AC power input to be converted to various voltages as required by the user console, and the second subsystem deriving power from the computer via a powerline of the Newcard device," as required by independent claim 1.

The Examiner argues that Odaohhara teaches "a power adapter connected to provide power to the second subsystem including the user console, whereby the power adapter is operable to received an AC power input to be converted to various voltages as required by the user console, and the second subsystem deriving power from the computer via a powerline." Office action dated 1/28/2008, page 4. Applicant respectfully disagrees that Odaohhara provides such a disclosure. Moreover, Applicant first points out the Examiner is neglecting to even consider all elements of the claim. Claim 1 clearly requires deriving power from the computer via a powerline of the Newcard device, not merely a "powerline" as indicated by the Examiner. The Examiner's arguments do not appear to even include an assertion that a powerline of a Newcard device is disclosed by Odaohhara, in fact, neglecting to provide any indication that the claim limitation is provided by any of the cited references, instead omitting the element from the discussion. MPEP 2143.03 states that "[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art." Quoting *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970). As the Examiner has failed to consider deriving power from the computer via a powerline of the Newcard device, for at least this reason, the Examiner has failed to illustrate a *prima facie* case of obviousness.

Furthermore, the cited portions of the system of Odaohhara do not provide deriving power from a powerline of a Newcard device. The Examiner cites to Fig. 1 as comprising power supply circuit 50 including AC adapter 51, a battery system 52, and a DC/DC converter 55. Office action mailed 1/28/2008, page 4. Even assuming, arguendo, that this power supply circuit provides for the claimed "power adapter," the claimed power means includes an

additional element. This element, "deriving power from the computer via a powerline of the Newcard device," is not disclosed by the power supply circuit 50. Fig. 1 including the power supply circuit 50 is reproduced below clearly illustrating the lack of a powerline of a Newcard device.



The Examiner further cites to Fig. 2 as illustrating "the detailed system on how power is provided to the plurality of computer sub-systems." Again, Fig. 2 provides for an AC adapter 51 or Battery power 52 source but provides no indication of power from the powerline of a Newcard device.

Sleeman and Saunders do not cure these deficiencies, nor does the Examiner contend they do. In the previous office action, the Examiner has stated "Sleeman as modified by Saunders does not explicitly disclose a power adapter connected to provide power to the second subsystem including the user console, whereby the power adapter is operable to receive an AC power input to be converted to various voltages as required by the user console, and the second subsystem deriving power from the computer via a powerline of the [N]ewcard device." Office action dated 8/14/2007, pages 3-4.

Therefore, it is impossible to render the subject matter of the claims as a whole obvious based on a single reference or any combination of the references, and the above explicit terms of the statute cannot be met. As a result, the USPTO's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met with respect to the claims, and a rejection under 35 U.S.C. §103(a) is not applicable.

There is still another compelling, and mutually exclusive, reason why the references cannot be combined and applied to reject the claims under 35 U.S.C. §103(a).

The PTO also provides in MPEP §2142:

[T]he Examiner must step backward in time and into the shoes worn by the hypothetical "person of ordinary skill in the art" when the invention was unknown and just before it was made. In view of all factual information, the Examiner must then make a determination whether the claimed invention "as a whole" would have been obvious at that time to that person. ...[I]mpermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.

Recently, the Supreme Court ruled that the "teaching, suggestion, or motivation (TSM) test" for determining obviousness still applies, but should be used in a more "expansive and flexible" manner. *KSR Int'l. Co. v. Teleflex Inc.*, 550 U.S. ___, 11 (2007). The Court stated that "a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. Although common sense directs one to look with care at a patent application that claims as innovation the combination of two known devices according to their established functions, it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. This is so because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known." *Id.* at 14-15, *emphasis added*.

In the present case, the Examiner has not expressed a reason why a person of ordinary skill in the art would combine Sleeman, Saunders and Odaohhara. If the Newcard of Saunders is combined with the system of Sleeman to support both PCIe and USB bus protocols, and further combined with the power system of Odaohhara, as suggested by the Examiner, the result would not include the power means, as is required by the claims. The claims combine a Newcard with an additional the purpose of deriving power from the powerline of the Newcard, which the suggested combination cannot achieve because the suggested combination would result in power only from a power supply including an AC adapter, DC/DC converter, and

battery (see Odaohhara Fig. 1). In view of the above, a person of ordinary skill in the art would not have a reason to combine Sleeman, Saunders, and Odaohhara. Therefore, there is simply no basis for combining the references to support a 35 U.S.C. §103(a) rejection of the claims.

Thus, in the present case it is clear that the USPTO's combination arises solely from hindsight based on the present disclosure without any reason why a person of ordinary skill in the art would combine the references as required by the claims. Therefore, for this mutually exclusive reason, the USPTO's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met with respect to the claims, and the rejection under 35 U.S.C. §103(a) is not applicable.

Therefore, independent claims 1, 11 and 21 and their respective dependent claims are submitted to be allowable.

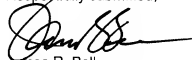
Applicant further notes the rejection of dependent claims 4, 6-10, 14, 16-20 and 21 as being unpatentable over the combination of Sleeman, Saunders and Cheng. Applicant in particular notes the omission of the Odaohhara reference and assume this to be an oversight by the Examiner. Regardless, Cheng does not cure the deficiencies of Sleeman, Saundser and/or Odaohhara. Cheng does not disclose, nor does the Examiner assert that Cheng discloses, a subsystem deriving power from a computer via a Newcard device. Cheng is directed only to a computer cooling system associated with a cooling fan.

In view of all of the above, the allowance of claims 1, 4, 6-11, 14 and 16-22 is respectfully requested.

The amended claims are supported by the original application.

The Examiner is invited to call the undersigned at the below-listed telephone number if a telephone conference would expedite or aid the prosecution and examination of this application.

Respectfully submitted,



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